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EXAMINER

LE, HIEU C

ART UNIT PAPER NUMBER

2153

DATE MAILED: 02/24/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/634,691

Applicant(s)

FLEMING, HOYT A.

Examiner

Hieu c. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-6,8-14,16,17 and 20-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6,8-14,16-17,20-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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***Response to Arguments***

1. The Amendment file 12/17/02 have been entered and made of record.
2. The Applicant's argument filed 12/17/02 have been fully considered but they are not persuasive for the following reasons:

Applicant alleges that "Hall reference fails [,]" (p. 4, line 20-p.5, line 6). The Applicant argument is not persuasive. Firstly, the Examiner can not find anywhere in the rejected claims that the unwanted messages are available to a user for further processing. Secondly, Hall teaches determining whether the sender is authorized or unauthorized (Abstract, lines 7-8). Hall clearly discloses that unwanted e-mail is received by the user "if unwanted e-mail does arrive on a valid channel" and is rejected or deleted (discard) unseen. However, the claims do not required or require or recite that the user is seeing the unwanted e-mail. As a matter of the fact Applicant's invention discard (deleted) the unwanted messages after storing them. Thirdly, Halls reference does not teach away from the present method because there is nothing in the claims that requires the user to be aware of the existence of the unwanted mail. Fourthly, Halls clearly shows that the unwanted e-mail message is received by the user and is rejected by the user (col. 5, lines 17-20).

Applicant alleges that " It is well understood [,]" (p. 5, line 22-p. 6, line 9). The Applicant argument is not persuasive. The Applicant is respectfully reminded that the rejection of the claim(s) is a combination of two references, references can not be argued individually to show nonobvious (see MPEP. 2145 (d)). Hall clearly discloses receiving e-mail messages and

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determining whether the message is from an authorized or non authorized sender. Hall does not disclose storing the messages of authorized sender in a first folder and the messages of unauthorized sender in a second folder. Gross in an analogous art discloses a system that transparently mapping specific mail message. Filters are used to automatically process messages in many folders. Messages are filtered in different folders with junk mail "unauthorized messages" in the trash folder "second folder" and other messages "authorized messages" in other folders (col. 17, lines 73-79). The motivation is recited in Gross in order to provide a flexible, efficient system which can transparently implemented in electronic mail applicant (col. 2, lines 40-43).

***Claim Rejections - 35 U.S.C. § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-6, 8, 11-14, 16, 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hall [US. Pat. No. 5,930,479] in view of Gross et al. [US. Pat. No. 5,283,856].

As to claim 1, Hall discloses a method in a computer system for filtering unauthorized electronic mail messages that are sent by senders to a user, each sender having an identification each electronic mail message including the identification of the sender (col. 8, lines 48-53, col. 10, line 30-33), the method comprising:

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providing a list of the identifications of the senders who are authorized to send an electronic mail message to the user [ a user channel database (list) that records a channel ID and address of the correspondent (col. 10, lines 26-42)];

for each of a plurality of electronic mail messages (fig. 2, items 208a, 210a),  
determining whether the sender of the electronic mail message is authorized by  
determining whether the identification of sender in the electronic mail message is in the provided list of the identifications of the senders who are authorized [send mail lookup user's name in the system password file (a standard database defining the valid users of the system, and separates the address into name and channel ID, and matches the channel ID of the incoming message with one of the lines in the channels file 212 (col. 11, lines 40-49) for verify that the message is authorized for delivery to the recipient (Abstract, lines 7-8)];

Hall does not disclose,

when the sender of the electronic mail message is determined to be not authorized, storing the electronic mail message in a second folder designated for electronic mail messages received from unauthorized senders; and

when the sender of the electronic mail message is determined to be authorized, storing the electronic mail message in a first folder designated for electronic mail messages received from authorized senders.

whereby the electronic mail messages are automatically stored in the appropriate folder based on whether the sender is authorized so that the user can view the first folder containing the

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electronic mail messages sent by authorized senders separately from the second folder containing the electronic mail messages sent by unauthorized senders.

Gross discloses a conditional rule based system which can be transparently implemented for mapping specific mail messages (col. 2, lines 40-54). If- then sequences are automatically used to process or “filter” messages in many folders. New/messages are filtered in different folders with Junk mail “unauthorized messages” in the trash folder and other new messages in other folders (col. 17, lines 73-79).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Gross’s teachings to modify Hall’s method by using an “If-then” filter to filter new incoming mail in different folders with junk mail “unauthorized mail” in a trash folder in order to provide a flexible, efficient system which can be implemented transparently to filter electronic - mail.

As to claim 2, Hall further discloses wherein when the user sends an electronic mail message to a recipient, the identification of the recipient is automatically added to the provided list of the identifications of senders who are authorized to send electronic mail message to the user (col. 12, lines 57-61).

As to claim 3, Hall further discloses wherein the provided list of the identifications of the senders is generated by adding the identification of senders of previously received electronic mail messages (col. 21, lines 56-63).

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As to claim 4, Hall further discloses wherein the provided list of the identifications of the senders is generated by adding the identification of recipients of previously sent electronic mail messages (col. 17, lines 26-30).

As to claim 5, Hall discloses a method in a computer system for filtering unauthorized messages, each message having a sender, the method comprising:

for each of a plurality of messages (Fig. 2, items 208a, 210a),

determining whether the sender of the message is designated as being authorized [send mail lookup user's name in the system password file (a standard database defining the valid users of the system), and separates the address into name and channel ID, and matches the channel ID of the incoming message with one of the lines in the channels file 212 (col. 11, lines 40-49) for verify that the message is authorized for delivery to the recipient (Abstract, lines 7-8)];

when the sender of the message is determined to be authorized, indicating that the message is from an authorized sender (col. 11, lines 48-50 and col. 12, lines 6-25).

Hall does not disclose,

when the sender of the message is determined to be not authorized,

storing the message in a predesignated location for messages sent by unauthorized senders.

Gross discloses a conditional rule based system which can be transparently implemented for mapping specific mail messages (col. 2, lines 40-54). If- then sequences are automatically used to process or "filter" messages in many folders. New/messages are filtered in different folders with

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Junk mail "unauthorized messages" in the trash folder and other new messages in other folders (col. 17, lines 73-79).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Gross's teachings to modify Hall's method by using an "If-then" filter to filter new incoming mail in different folders with junk mail "unauthorized mail" in a trash folder in order to provide a flexible, efficient system which can be implemented transparently to filter electronic mail.

As to claim 6, Hall further discloses wherein the recipient of the messages can identify whether a message is authorized based solely on the indications [the message is either accepted or rejected (col. 11, lines 48-52)].

As to claim 8, Hall further discloses wherein the message is an electronic mail message and the pre-designated location is a folder [ the message is an e-mail message (col. 5, line 8) and the authorized message is discarded (i.e. stored in a deleted file) (col. 22, lines 15-19)].

As to claim 11, Hall further discloses wherein the computer system includes a list of authorized senders (col. 10, lines 26-42 & Fig. 4) and wherein the determining whether the sender of the message is designated as being authorized includes determining whether the sender is in the list of authorized senders (col. 11, lines 40-49, col. 21, lines 56-63).

As to claim 12, Hall further discloses wherein the list of authorized senders is generated by adding the senders of the previously received messages to the list (col. 21, lines 56-63).



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As to claim 13, Hall further discloses wherein the list of authorized senders is generated by adding the recipients of the previously sent messages to the list (col. 17, lines 26-30).

As to claim 14, Hall further discloses wherein the list is shared by multiple users (col. 9, lines 44-47, Fig. 2).

As to claim 16, Hall further discloses wherein when the recipient sends a message to an intended recipient, the intended recipient is added to the list as an authorized sender (col. 12, lines 57-61).

As to claim 20, refer to claim 1 rejection.

As to claim 21, refer to claim 2 rejection.

As to claim 22, refer to claim 3 rejection.

As to claim 23, Hall uses a filter to reject unauthorized messages by discarding (i.e. forwarding the message to a delete folder) (col. 22, lines 15-19).

Hall does not explicitly disclose that the folder is labeled Junk mail. However, it is obvious to label a folder that is labeled discard and contains filtered e-mail from unauthorized sender and is used in the context of filtering Junk mail.

5. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hall [US. Pat. No. 5,930,479] in view of Gross et al. [US. Pat. No. 5,283,856] as applied to claim 5 above and further in view of Birrell et al. [US. Pat. No. 6,092,101].

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As to claim 9, neither Hall nor Gross discloses including when displaying a list of messages, displaying a visual indication as to whether the message has been indicated as being sent from an authorized or unauthorized sender.

Birrell discloses a system for filtering unauthorized messages, messages from authorized senders is placed in the Inbox (col. 11, lines 41-44) (i.e. the message is indicated by a label Inbox for the user's attention) messages from unauthorized senders only given the unread label (col. 11, lines 45-46), the messages are displayed and labeled as Inbox or unread (col. 9, lines 9-18).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Birell's teachings to modify the combined method of Hall and Gross by displaying a visual indication (label) to indicate that the message is from authorized sender (Inbox) or unauthorized sender (unread) in order to facilitate mail handing, particularly for some one receiving a large amount of e-mail and reduce the amount of junk e-mail he receives.

6. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hall [US. Pat. No. 5,930,479] in view of Gross et al [US. Pat. No. 5,283,856] in view of Birrell et al. [US. Pat. No. 6,092,101] as applied to claim 9 and further in view of Microsoft Corporation, "Excerpts from online documentation of Microsoft Exchange", version 5.0.1458.47, 1986-1997, 11pp.

As to claim 10, neither Hall nor Gross nor Birell disclose the limitation, wherein the visual indication is the dimming of the messages that are sent from unauthorized senders in the list of messages.

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Microsoft Corporation discloses a visual indication method used in e-mail message to dim profile message (page 8).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Microsoft's teaching to modify the combined method of Hall, Gross and Birell by dimming the junk mail messages in the list of messages in order to indicate to the user that these messages are irrelevant to his interest and save him valuable hours to be wasted in dealing with junk mail.

7. Claims 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hall [US. Pat. No. 5,930,479] in view of Gross et al [US. Pat. No. 5,283,856] as applied to claim 5 and further in view of Canale et al. [US. Pat. No. 5,619,648].

As to claim 17, neither Hall nor Gross disclose wherein the indicating that the message is from an unauthorized sender includes forwarding the message from an unauthorized to another user.

Canale discloses a method for reducing the amount of junk e-mail received by a user of an e-mail system. The mail filter for potential recipient has access to a list of the e-mail messages sent and received by the potential recipient and used the list of e-mail messages to determine correspondents of the potential recipient and forwards the messages to those recipients (col. 2, lines 27-44). The system permits the recipient of the e-mail to select which of the correspondents (another users) is to receive the e-mail (col. 4, lines 2-8).

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Canale's teaching to modify the combined method of Hall and Gross' in order to facilitate mail handling, particularly for some one receiving a large amount of e-mail and reduce the amount of junk e-mail he receives.

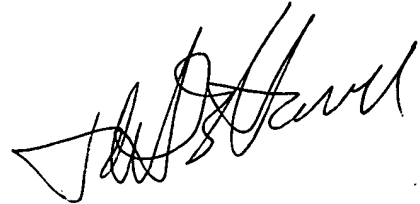
7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Hieu Le whose telephone number is (703) 306-3101. The examiner can normally be reached on Monday to Friday from 8:00 A.M. to 4:00 P.M..  
  
The fax number of this Group 2757 is (703) 308-5397 or 308-9051 .

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

A handwritten signature in black ink, appearing to read "Robert B. Harrell", written in a cursive style.

**ROBERT B. HARRELL  
PRIMARY EXAMINER**